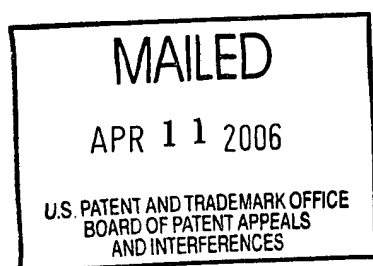# UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte Daniel Garfinkel, James Cooke, Maureen Gills,
Hugh-John Flemming, and John Christopher Dale

MAILED

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U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Appeal No. 2006-0166
Application No. 09/687,774

ON BRIEF

Before RUGGIERO, GROSS, and BARRY, *Administrative Patent Judges.*

BARRY, *Administrative Patent Judge.*

A patent examiner rejected claims 1-20. The appellants appeal therefrom under

35 U.S.C. § 134(a). We affirm-in-part.

I. BACKGROUND

The invention at issue on appeal concerns computer-based meetings. (Spec.

at 1.) Computer-based collaboration tools, which enable remotely located users to

view data and communicate via a computer network, can be used to conduct online

meetings. Just as in face-to-face meetings, notes need to be taken during an online

meeting to capture the events, issues, action items, and decisions made during the

meeting. In the past, participants of an online meeting took notes individually and then

distributed the notes via paper memoranda or electronic mail. (*Id.*)

In contrast, the appellants' invention captures electronic notes, preferably along

with the time of creation, author, and context. For example, the topic under discussion

and the current display on the computer screen may be captured and associated with

the note. The context associated with the captured note thereby allows a user to better

understand the meaning of the note when the note is retrieved at a later time. (*Id.* at 2.)

A further understanding of the invention can be achieved by reading the

following claims.

1. A notes service for a computer aided design (CAD) application,
comprising:

a note creation module which captures an electronic note
associated with a change in a three-dimensional model of said CAD
application;

a note storage module which stores said captured note and an
associated data file for later retrieval; and

a note retrieval module for retrieving and displaying said captured
note with a display screen of said three-dimensional model, that existed
when said note was generated, using said associated data file.

5. A method for capturing and managing electronic notes in a computer aided design (CAD) based application, comprising:

capturing a note in a note object; and

associating a data file with said captured note, wherein said data file is used to generate a display of a three-dimensional model of said CAD application that existed when said note was captured.

Claims 1-20 are rejected under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 6,342,906 ("Kumar").

II. OPINION

Our opinion addresses the claims in the following order:

- claims 1-4
- claims 5, 6, 10-14, 16, and 18-20
- claim 8
- claim 9
- claims 7, 15, and 17.

A. CLAIMS 1-4

"Rather than reiterate the positions of the examiner or the appellants *in toto*, we focus on the point of contention therebetween." *Ex parte Muresan*, No. 2004-1621, 2005 WL 951659, at *1 (Bd.Pat.App & Int. Feb 10, 2005). To wit, the examiner makes the following assertions.

> [T]he reference provides relevant data structures associated with the underlying application. It is precisely this application that suggests an associated data file for later retrieval. As presently claimed, the only requirement for the data file is that it has to somehow be associated with the note. If the user edits the drawing and the underlying application is not synchronized with the other users within the workspace then the drawing must be stored through the utilization of a data structure and the related application.

(Examiner's Answer at 8.) The appellants argue, "the underlying application data file of Kumar cannot address the claimed subject matter, because the application data file will not enable the user to view a display of 'a three-dimensional model that existed when said note was generated using said associated data file.'" (Reply Br. at 4.)

"In addressing the point of contention, the Board conducts a two-step analysis. First, we construe the independent claim at issue to determine its scope. Second, we determine whether the construed claim would have been obvious." *Ex parte Sehr*, No. 2003-2165, 2005 WL 191041, at *3 (Bd.Pat.App & Int. 2004).

1. Claim Construction

"Analysis begins with a key legal question — *what* is the invention *claimed*?" *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1567, 1 USPQ2d 1593, 1597 (Fed. Cir. 1987). In answering the question "[t]he Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art." *In re Lowry*, 32 F.3d 1579, 1582, 32 USPQ2d 1031, 1034 (Fed. Cir. 1994) (citing *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 403-04 (Fed. Cir. 1983)).

Here, claim 1 recites in pertinent part the following limitations: "a note storage module which stores said captured note and an associated data file for later retrieval; and a note retrieval module for retrieving and displaying said captured note with a display screen of said three-dimensional model, that existed when said note was generated, using said associated data file." Considering all the limitations, the independent claim requires capturing data at a first time, storing data associated with the captured data, and, **at a time after the first time**, using the associated data to show a display that existed at the first time.

2. Obviousness Determination

"Having determined what subject matter is being claimed, the next inquiry is whether the subject matter would have been obvious." *Sehr*, 2005 WL 191041, at *3. "In rejecting claims under 35 U.S.C. Section 103, the examiner bears the initial burden of presenting a *prima facie* case of obviousness." *In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993) (citing *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992)). "'A *prima facie* case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art.'" *In re Bell*, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993) (quoting *In re Rinehart*, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976)).

Here, Kumar "provides a mechanism for a consistent, real-time collaboration environment in which any type of data can be shared in a common work space. In this invention, users connected to the system and engaged in a collaborative session share a common work space that is presented via each user's computer connected through a network. The data in the shared work space can be anything; e.g., a spreadsheet, an image, a simple text file, a text document, a drawing, a project schedule, a three-dimensional view, or any custom data." Col. 3, ll. 39-48.

The examiner's aforementioned assertions are based on his premise that an "underlying application is not synchronized with the other users within the work-space. . . ." (Examiner's Answer at 8.) We are unpersuaded, however, that Kumar employs an application that is not synchronized with users within a workspace. To the contrary, the reference explains that the "work space for each participant is kept synchronized with everyone else." Col. 3, ll. 48-49. In other words, "[t]he applications, of course, will be synchronized among all clients either through replication of user input or by other means, so that when a user edits the data on one client, all the clients will display the changed data." Col. 4, ll. 32-36.

Because the examiner's assertions are based on a premise that Kumar appears to contradict, we are unpersuaded of a *prima facie* case of obviousness. Therefore, we reverse the rejection of claim 1 and of claims 2-4, which depend therefrom.

B. CLAIMS 5, 6, 10-14, 16, AND 18-20

The appellants correctly note (Reply Br. at 2), that 37 C.F.R. § 41.37 (Sep. 30, 2004) was in effect when they filed their appeal brief. This Rule includes the following regulations:

When multiple claims subject to the same ground of rejection are argued as a group by appellant, the Board may select a single claim from the group of claims that are argued together to decide the appeal with respect to the group of claims as to the ground of rejection on the basis of the selected claim alone. Notwithstanding any other provision of this paragraph, the failure of appellant to separately argue claims which appellant has grouped together shall constitute a waiver of any argument that the Board must consider the patentability of any grouped claim separately.

37 C.F.R. § 41.37(c)(1)(vii). Furthermore, "[a] statement which merely points out what

a claim recites will not be considered an argument for separate patentability of the

claim." *Id.*

Here, the appellants argue claims 5, 6, 10-14, 16, and 18-20 as a group.

(Appeal Br. at 6-7.) We select claim 5 from the group as representative of the claims

therein.

1. Claim Construction

"[T]he Board must give claims their broadest reasonable construction. . . ." *In re*

Hyatt, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1668 (Fed. Cir. 2000). "Moreover,

limitations are not to be read into the claims from the specification." *In re Van Geuns*,

988 F.2d 1181, 1184, 26 USPQ2d 1057, 1059 (Fed. Cir. 1993) (citing *In re Zletz*, 893

F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989)).

Here, claim 5 recites in pertinent part the following limitations: "associating a data file with said captured note, wherein said data file is used to generate a display of a three-dimensional model of said CAD application that existed when said note was captured." Giving the representative claim its broadest, reasonable construction, the limitations require capturing data, associating other data with the captured data, and using the associated data to show a display that exists at some time. In contrast to claim 1, however, claim 5 does not require the display be shown at a time after the time when the note was captured. In other words, the claim can read on showing a display as it exists at the same time the former data are captured.

2. Obviousness Determination

The question of obviousness is "based on underlying factual determinations including . . . what th[e] prior art teaches explicitly and inherently. . . ." *In re Zurko*, 258 F.3d 1379, 1383, 59 USPQ2d 1693, 1696 (Fed. Cir. 2001) (citing *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966); *In re Dembiczak*, 175 F.3d 994, 998, 50 USPQ 1614, 1616 (Fed. Cir. 1999); *In re Napier*, 55 F.3d 610, 613, 34 USPQ2d 1782, 1784 (Fed. Cir. 1995)). Here, Kumar "uses an annotation layer for handling the discussion mode on top of any synchronized work space. The annotation layer appears as a transparent graphical object that covers the shared window

displaying the synchronized application and the shared data. During the discussion

mode, it appears to the user as if the application is covered by this transparent

layer. . . ." Col. 4, ll. 11-17.

In the discussion mode, "a user will be engaged in discussing the shared work

space data with others. This will involve . . . marking over a portion using a pen or

some other drawing tool, or writing some annotating text over some portion of

the work space." Col. 3, l. 63 - col. 4, l. 1. "The annotation layer appears to handle

each user input such as mouse and keyboard events to generate appropriate action

such as moving a cursor, selecting a drawing tool and marking over an area or placing

annotation text." Col. 4, ll. 18-22. Because "a user's input from, say, a mouse 31 and a

keyboard 32 are captured and displayed on the transparent annotation layer 33," *id.* at

ll. 41-44, we find that Kumar captures such input as data.

Because "[t]he annotation layer 33 itself is synchronized with the work space

[34] underneath, so that the markings change appropriately when the application

display is moved, resized or when the display inside is scrolled," *id.* at ll. 46-49,

moreover, we find that "the underlying shared data," *id.* at l. 25, are associated with the

captured data. "FIG. 2 is an illustration of the annotation layer according to [Kumar's]

invention in which a transparent whiteboard-like layer covers the shared work space

and on which annotation, shared cursor(s) motion and other markings can be made."

Col. 3, ll. 1-4. At the moment user input corresponding to the "MARKINGS" shown in

the Figure are captured via the "ANNOTATION LAYER," we find that Kumar's

underlying data show the display of the "WORK SPACE" that exists when the

"MARKINGS" data are captured. Therefore, we affirm the rejection of claim 5 and of

claims 6, 10-14, 16, and 18-20, which fall therewith.

C. CLAIM 8

The examiner correctly finds that the collaboration enabled by Kumar's "will

involve viewing different parts of the work space, pointing to some part of the work

space, marking over a portion using a pen or some other drawing tool, or *writing some*

annotating text over some portion of the work space. See column 3, lines 60-67."

(Examiner's Answer at 6.) The appellants argue, "there is no teaching or suggestion in

Kumar to display a previously captured note." (Appeal Br. at 8.)

1. Claim Construction

Claim 8 recites in pertinent part the following limitations: "displaying said note captured in said note object." Giving the representative claim its broadest, reasonable construction, the limitations require displaying captured data.

2. Obviousness Determination

As explained regarding claims 5, 6, 10-14, 16, and 18-20, Figure 2 of Kumar shows that his invention displays captured "MARKINGS" data. Therefore, we affirm the rejection of claim 8.

D. CLAIM 9

The examiner correctly finds that a "three-dimensional view . . . [is] provided . . . by the primary reference. . . ." (Examiner's Answer at 3.) The appellants argue, "there is no displaying the three-dimensional model that existed at the time the note was captured using the associated data file in conjunction with displaying the captured note." (Appeal Br. at 8.)

1. Claim Construction

Claim 9 recites in pertinent part the following limitations: "presenting said display of said three-dimensional model using said data file." Giving the claim its broadest, reasonable construction, the limitations require that the display show a three-dimensional ("3D") model.

2. Obviousness Determination

As explained regarding claims 5, 6, 10-14, 16, and 18-20, we found Kumar shows the display of a work space that exists when marking or writing data are captured. Furthermore, the reference explains that "[t]he data in the shared work space can be . . . a three-dimensional view," col. 3, ll. 46-49, "[f]or example, . . . a three dimensional view of a room. . . ." Col. 4, l. 5. When the shared data comprise a 3D view of a room, we find that Kumar displays a 3D model of that room. Therefore, we affirm the rejection of claim 9.

E. CLAIMS 7, 15, AND 17

"[P]oint[ing] to Kumar, column 9, lines 3-41," (Examiner's Answer at 9), the examiner makes the following assertions.

> [T]he reference discloses the control modifications can change the
> available options on the display bar of the input layer. The control
> modifications can change and/or restrict the modes available to any
> client. The process begins by receiving the user input in [sic]. The
> reference suggests query conditions for the retrieval of user input and
> new segments within the note retrieval methods of Kumar.

(*Id.*) The appellants argue, "The disclosure of Kumar relied upon by the Examiner is

clearly insufficient to satisfy the limitation related to the query condition. . . ." (Appeal

Br. at 8.)

1. Claim Construction

Claims 7 and 15 recite in pertinent part the following limitations: "receiving a

query condition; and retrieving said note object and said associated data file if

attributes of said note object meet said query condition." Considering all the

limitations, both claims require receiving and processing a query specifying data to be

retrieved.

2. Obviousness Determination

Contrary to the examiner's assertion, we are unpersuaded that an input for

changing or restricting modes available to a client, teaches or would have suggested a

query specifying data to be retrieved. Therefore, we reverse the rejection of claims 7

and 15 and of claim 17, which depends from claim 15.

III. CONCLUSION

In summary, the rejection of claims 1-4, 7, 15, and 17 under § 103(a) is reversed. The rejection of claims 5, 6, 8-14, 16, and 18-20 under § 103(a), however, is affirmed.

"Any arguments or authorities not included in the brief will be refused consideration by the Board of Patent Appeals and Interferences. . . ." 37 C.F.R. § 1.192(a). Accordingly, our affirmance is based only on the arguments made in the briefs. Any arguments or authorities omitted therefrom are neither before us nor at issue but are considered waived. *Cf. In re Watts*, 354 F.3d 1362, 1367, 69 USPQ2d 1453, 1457 (Fed. Cir. 2004) ("[I]t is important that the applicant challenging a decision not be permitted to raise arguments on appeal that were not presented to the Board.") No time for taking any action connected with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED-IN-PART

JOSEPH F. RUGGIERO
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